UNITED STATES PATENT AND TRADEMARK OFFICE
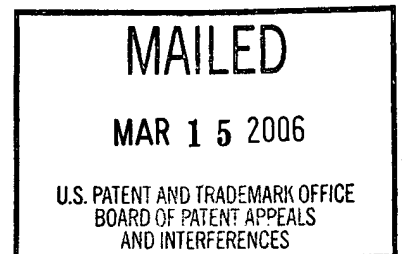
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

<u>Ex parte</u> SAMPATH SRINIVAS and THERON TOCK

Appeal No. 2006-0498
Application No. 09/706,296

ON BRIEF

MAILED

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U.S. PATENT AND TRADEMARK OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES

Before HAIRSTON, KRASS, and RUGGIERO, <u>Administrative Patent Judges</u>.
KRASS, <u>Administrative Patent Judge</u>.

<u>DECISION ON APPEAL</u>

This is a decision on appeal from the final rejection of claims 1-4, 6-10, 17-20, and 22.

The invention pertains to accessing resources over a network, such as the Internet. In particular, the invention is concerned with increasing the functionality and services available to users of network browsers. More particularly, a toolbar is provided or inserted in a markup language document so as to facilitate features or functionality provided by a server.

Representative independent claim 1 is reproduced as follows:

1. A method for inserting a toolbar into a webpage comprising:

   receiving a webpage at a server to be delivered to a client;

   inserting an executable script into each frame of the webpage operable to render a toolbar in each frame when executed by a client browser, the toolbar including at least one link to a resource; and

   delivering the webpage including the executable script to the client.

The examiner relies on the following references:

Pacifici et al. (Pacifici)	6,230,171	May 08, 2001 (filed Aug 29, 1998)
Guthrie	6,266,681	Jul. 24, 2001 (filed Apr. 08, 1997)
Kanevsky	6,300,947	Oct. 09, 2001 (filed Jul. 06, 1998)

Chennapragada et al. (Chennapragada)6,701,368   Mar. 02, 2004
(filed Apr. 26, 1999)

Claims 1-4, 6-10, 17-20, and 22 stand rejected under 35

U.S.C. § 103. As evidence of obviousness, the examiner offers

Guthrie and Pacifici with regard to claims 1-4, 6, 8-10, 19, and

20, adding Kanevsky with regard to claim 7. With regard to

claims 17, 18, and 22, the examiner offers Guthrie, Kanevsky and

Chennapragada.

Reference is made to the briefs and answer for the

respective positions of appellants and the examiner.

OPINION

In rejecting claims under 35 U.S.C. § 103, it is incumbent

upon the examiner to establish a factual basis to support the

legal conclusion of obviousness. See In re Fine, 837 F.2d 1071,

1073, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). In so doing, the

examiner is expected to make the factual determinations set forth

in Graham v. John Deere Co., 383 U.S. 1, 17, 148 USPQ 459, 467

(1966), and to provide a reason why one having ordinary skill in

the pertinent art would have been led to modify the prior art or

to combine prior art references to arrive at the claimed

invention. Such reason must stem from some teachings,

suggestions or implications in the prior art as a whole or

knowledge generally available to one having ordinary skill in the art. Uniroyal, Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 1051, 5 USPQ2d 1434, 1438 (Fed. Cir.), cert. denied, 488 U.S. 825 (1988); Ashland Oil, Inc. v. Delta Resins & Refractories, Inc. , 776 F.2d 281, 293, 227 USPQ 657, 664 (Fed. Cir. 1985), cert. denied, 475 U.S. 1017 (1986); ACS Hosp. Sys., Inc. v. Montefiore Hosp., 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). These showings by the examiner are an essential part of complying with the burden of presenting a prima facie case of obviousness. Note In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). If that burden is met, the burden then shifts to the applicant to overcome the prima facie case with argument and/or evidence. Obviousness is then determined on the basis of the evidence as a whole and the relative persuasiveness of the arguments. See Id.; In re Hedges, 783 F.2d 1038, 1039-1040, 228 USPQ 685, 687 (Fed. Cir. 1986); In re Piasecki, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984); and In re Rinehart, 531 F.2d 1048, 1051, 189 USPQ 143, 146-147 (CCPA 1976).

Only those arguments actually made by appellants have been considered in this decision. Arguments which appellants could have made but chose not to make in the briefs have not been considered and are deemed to be waived [see 37 CFR § 41.67(c)(1)(vii)].

Regarding claimi 1, it is the examiner's position that Guthrie teaches a method of inserting a toolbar into a webpage at column 3, lines 30-42, wherein the webpage is received at a remote server (column 5, lines 17-22, and column 7, lines 44-51) to be delivered to a client (column 3, lines 30-36). The examiner cites column 11, lines 31-53, for inserting an executable script into the webpage operable to render a toolbar when executed by a client browser (further citing column 3, lines 30-41, and column 5, lines 45-58), and column 5, lines 45-58, for the toolbar including at least one link to a resource. Column 3, lines 30-41, and column 11, lines 31-53, are said to teach delivering the webpage including the executable script to the client. The examiner also points to column 5, lines 41-45, of Guthrie for a teaching that a webpage may have more than one frame, and to column 3, lines 51-62, for a teaching that an instance of an executable script may be inserted into a frame.

Moreover, according to the examiner, column 6, lines 41-49, of the reference teaches that the script is operable to render the toolbar into that frame.

The examiner asserts that the "toolbar can be considered an HTML component" (column 3, lines 30-41), and that, in accordance with column 11, lines 25-32, of Guthrie, the artisan would recognize variations to the code inserted based on the parameters of the HTML document.

The examiner recognizes that Guthrie does not explicitly disclose an instance of the executable script being inserted into each frame of a webpage with more than one frame, but asserts that the reference does describe embodiments that include multiple frames.

The examiner relies on Pacifici for the use of a script (column 4, lines 27-35) that is inserted into each frame of a webpage that has more than one frame (column 5, lines 22-25). The examiner contends that this script is operable to render HTML components into that frame (column 2, lines 59-67, and column 5, lines 22-38, of Pacifici).

The examiner concludes that it would have been obvious to take Guthrie's method and modify it as indicated by Pacifici such that the method further comprises inserting an executable script

into each frame of the webpage operable to render the toolbar in each frame when executed by a client browser. The examiner reasons that "there is need for a user to be able to incorporate add-on components in a webpage including webpages with multiple frames (Col. 3 lines 1-29 of Guthrie)" (answer-page 5).

Appellants argue that neither Guthrie nor Pacifici discloses or suggests inserting an executable script into each frame of the webpage operable to render a toolbar in each frame when executed by a client browser. Appellants assert that while the examiner admits that Guthrie lacks this teaching and relies on particular portions of Pacifici for these claim limitations, the portions of Pacifici relied on disclose only the ability to dynamically add HTML annotations to HTML documents, with no disclosure that such annotations constitute a toolbar, or the rendering of a toolbar in each frame of a webpage, as claimed (see pages 6-7 of the principal brief).

Moreover, appellants contend that even if the annotations of Pacifici could, somehow, be considered a toolbar, there is no disclosure or suggestion in Pacifici of inserting those annotations into each frame of a webpage that is operable to render a toolbar in each frame when executed by a client browser, where the toolbar includes at least one link to a resource.

It is true that the examiner admits that Guthrie does not

disclose an instance of the executable script being inserted into

each frame of a webpage with more than one frame (answer-page 4),

but the examiner does assert that Guthrie teaches that a webpage

may have more than one frame (column 5, lines 41-45) and that an

instance of an executable script may be inserted into a frame

(column 3, lines 51-62) with script operable to render the

toolbar into that frame (column 6, lines 41-49, and column 5,

lines 45-48) (answer-page 10).[1]   Pacifici is relied on for the

teaching of using a script that is inserted into each frame of a

webpage with more than one frame.

The examiner indicates column 4, lines 27-35, column 5,

lines 22-38, and column 2, lines 59-67, of Pacifici as teaching

the claimed limitation of inserting a script into each frame of a

webpage that has more than one frame, wherein the script is

operable to render HTML components into that frame. Pacifici is

concerned with a markup system for shared HTML documents wherein

annotations are created by the markup system using HTML

components. At the portions cited by the examiner, Pacifici does

recite that HTML documents may be composed of multiple frames or

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[1]At pages 1-2 of the reply brief, appellants assert that these statements by the examiner are
contradictory. We disagree. As we read the examiner's statements, it appears to us that the examiner is
asserting that Guthrie does not disclose the *multiple* frame aspect of the claimed invention but does
disclose the aspect of inserting a script into *a* frame.

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windows, that markup agent 412 is associated with each frame, and that a markup system capable of directly annotating HTML documents displayed inside a browser's window is provided.

We have reviewed the evidence before us, including the applied references and the arguments of appellants and the examiner. It appears to us that the argument between appellants and the examiner relative to inserting executable script into each frame of a webpage with more than one frame is moot. We need not decide whether Pacifici provides for employing a script that is inserted into each frame of a webpage "with more than one frame" because instant independent claims 1 and 19 do not require a webpage "with more than one frame." Rather, these claims require the insertion of an executable script into "each" frame of the webpage, but a webpage having only a single frame into which an executable script is inserted meets the language of the claims.

Therefore, since Pacifici is employed for a teaching of using a script that is inserted into each frame of a webpage with more than one frame, it would appear that Guthrie, alone, would be sufficient to meet the instant claim language if the reference discloses what the examiner asserts it discloses.

The injected user interface component 305 in Guthrie's
Figure 3 does appear to be a "toolbar," as claimed. Appellants
contend, at page 2 of the reply brief, that this cannot be the
"toolbar," as claimed because Guthrie specifically discloses, at
column 5, lines 64-66, that "only one instance of injectable
component 305 is generated and displayed in the browser
application window 303..." Therefore, contend appellants,
Guthrie specifically teaches away from inserting an executable
script into each frame of the webpage operable to render a
toolbar in each frame when executed by a client browser. We
disagree. In the case where there is only one frame of a
webpage, the "toolbar" 305 of Guthrie meets the claim language
since the script is inserted into "each" frame in that case.

At the bottom of page 2 of the reply brief, appellants argue
that claim 1 requires an "executable script" to be inserted into
each frame, but appellants never explain why they believe that
the script of injectable component 305 in Guthrie is not
"executable" script, nor do appellants define this term. A
normal reading of "executable" would appear to us to mean
something that is capable of being executed. Since the component
305 in Guthrie contains a drop-down menu 309 and several
graphical buttons 310, which provide links to portions of a 5-day

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weather forecast, the script inserted into the frame in Guthrie is interpreted to be "executable," as claimed.

Accordingly, we will sustain the rejection of claims 1-4, 6, 8-10, 19 and 20 under 35 U.S.C. § 103.

Turning to independent claim 17, this claim does require a "webpage having more than one frame." But this claim stands rejected under 35 U.S.C. §103 over the combination of Guthrie, Kanevsky, and Chennapragada.

The examiner contends that Guthrie discloses the instant claimed subject matter but for the use of computer program code for determining a size of each frame of the webpage using the HTML code and the condition for rendering specified by the activation script being a threshold size compared to the determined size of the frame. However, the examiner relies on Kanevsky for a system for conditionally adding webpage components depending on the size of the viewing area (column 2, lines 12-19, and column 10, lines 45-51). In Kanevsky, if the viewing area size exceeds a threshold size, then the component will be displayed.

The examiner relies on Chennapragada for a teaching that the visible size of each frame is inherently determined by the HTML code (column 5, lines 58-60).

The examiner then concludes that it would have been obvious to take the method of Guthrie and modify it with the teachings of Kanevsky and Chennapragada such that the computer readable medium further comprises computer program code for determining the size of each frame of the webpage using the HTML code; and computer code for rendering the toolbar in each of the frames of the webpage when the size of a frame exceeds a threshold size and not rendering the toolbar in each of the frames of the webpage when the size of a frame does not exceed the threshold value. The examiner's reason for making the combination is that "it is desired to have webpage material presented in a friendly and useful manner to the client (Col. 2 lines 2-5 of Kanevsky)" (Final rejection of Aug. 18, 2004-page 8).

We will not sustain the rejection of claims 17, 18, and 22 under 35 U.S.C. § 103 because claim 17 requires, inter alia, that a determination of whether an activation script for rendering a toolbar is within HTML code for each frame of a "webpage having more than one frame." The examiner relies on Guthrie for this limitation, but appellants reasonably point out that Guthrie's

Figure 3, and column 5, lines 63-65, appear to indicate that only

a single instance of the injectable component (i.e., the

"toolbar" 305) is genrated and displayed in the browser

application window 303. Accordingly, it would appear contrary to

the teachings of Guthrie for the examiner to contend that Guthrie

actually teaches the rendering of a toolbar for each frame of a

webpage "having more than one frame."

The examiner relies on Guthrie's teaching that a webpage may

have more than one frame (at column 5, lines 41-45, viz., "three

pre-existing frames of the HTML document") and that an instance

of an executable script may be inserted into a frame (column 3,

lines 51-62). However, assuming the examiner's allegations to be

true, we agree with appellants, at page 15 of the principal

brief, that the "mere fact that Guthrie discloses rendering a

toolbar in a webpage and that a webpage can include multiple

frames would not reasonably lead one skilled in the art to

conclude that Guthrie discloses rendering a toolbar in each frame

of a webpage, as required by claim 17." In fact, for the reasons

argued by appellants, Guthrie does appear to teach away from

rendering a toolbar in each frame of a webpage "having more than

one page."

Since neither Kanevsky nor Chennapragada provides for this deficiency of Guthrie, no prima facie case of obviousness has been shown by the examiner. Moreover, even if we were to reach the question of the combinability of the three references, the examiner's very general allegation of making the combination because "it is desired to have webpage material presented in a friendly and useful manner to the client" appears suspect to us. A stronger motivation would be required, within the meaning of 35 U.S.C. § 103, to modify Guthrie to include the determination of a size of each frame of the webpage using the HTML code and then rendering or not rendering a toolbar in dependence on a threshold frame size.

With regard to the rejection of claim 7 under 35 U.S.C. § 103 over the combination of Guthrie, Pacifici and Kanevsky, the examiner relies on Kanevsky for conditionally adding website components depending on the size of the viewing area (column 2, lines 12-19, and column 10, lines 45-51). The examiner contends that Guthrie already teaches conditionally displaying a toolbar, with the condition being determined by the activation script (column 6, lines 41-56). The examiner determines that it would have been obvious to modify Guthrie's method by Pacifici and Kanevsky to meet the limitations of claim 7 because "it is

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desired to have webpage material presented in a friendly and useful manner to the client" (Final rejection of Aug. 18, 2004-page 9).

Besides the rather gratuitous, general statement of the reason for combining being to present material in "a friendly...manner," the examiner's rationale falls short of establishing a prima facie case of obviousness. We agree with appellants (principal brief-page 11) that Kanevsky is concerned with providing information anent screen or window information, but does not appear to suggest determining the size of a frame in which a toolbar is to be displayed using an activation script inserted into the frame. While column 10, lines 45-62, of Kanevsky discloses the determination of whether to render objects based on the size of the objects and the screen size, it does not appear to suggest determining the size of a frame in which a toolbar is to be displayed, or that the size of the frame is determined using the activation script inserted into the frame.

The examiner contends that it is the combination of Guthrie and Pacifici which teaches the insertion of the script into a frame to render a toolbar in the frame and the conditional

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displaying of a toolbar based on conditions determined by the
activation script (column 6, lines 41-56 of Guthrie). Kanevsky
is relied on for the teaching of rendering a component based on a
condition, that condition being the size of a window or screen.

Merely because Kanevsky may teach the expansion of web pages
based on the size of a display, we fail to see how such a
teaching would have led the artisan to modify the Guthrie/
Pacifici combination in such a manner as to render the toolbar
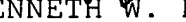305 in Guthrie for a frame based on the size of the frame.

Since we find that the examiner's rationale for rejecting
claim 7 under 35 U.S.C. § 103 is not sufficient to establish a
prima facie case of obviousness, we will not sustain the
rejection of claim 7 under 35 U.S.C. § 103.

We have sustained the rejection of claims 1-4, 6, 8-10, 19,
and 20 under 35 U.S.C § 103 but we have not sustained the
rejection of claim 7 or of claims 17, 18, and 22 under 35 U.S.C.
§ 103. Accordingly, the examiner's decision is affirmed-in-part.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED-IN-PART

KENNETH W. HAIRSTON   )
Administrative Patent Judge   )
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) BOARD OF PATENT
ERROL A. KRASS   )   APPEALS
Administrative Patent Judge   )   AND
)   INTERFERENCES
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